

IN THE

Supreme Court of the United States

OCTOBER TERM 1944

No.

JERRY VOGEL MUSIC Co., INC.,

Petitioner,

against

FORSTER MUSIC PUBLISHERS, INC.,

Respondent.

**BRIEF IN SUPPORT OF PETITION FOR
WRIT OF CERTIORARI**

Jurisdiction

The statement of jurisdiction is set forth in the foregoing petition.

Statement of the Case

The facts have been set forth in the foregoing petition.

Specification of Errors

The errors which petitioner will urge if the writ of certiorari is granted are that the Circuit Court of Appeals for the Second Circuit erred:

(1) In affirming the decree of the District Court and holding that Taylor was the sole author, and, therefore, the plaintiff is the owner of the renewal term of copyright.

(2) In concluding that under Section 55 of the Copyright Law the original certificate of copyright (Ex. 1), in addition to being prima facie proof of the facts stated therein, was also prima facie proof of sole authorship by Taylor.

(3) In concluding that if Smith had no interest in the original term of copyright he had no right to apply for and to receive a renewal certificate.

(4) In disregarding the pleadings and issues raised and holding that defendant had the burden of proving an affirmative defense, in the absence of such defense in the pleadings.

(5) In holding that Smith's testimony was properly excluded under Section 347 of the New York State Civil Practice Act.

(6) In affirmatively finding that Smith had made no legal or formal claim to the copyright during the first term of copyright. Assuming that there was no other evidence, the exclusion of Smith's testimony under Section 347 left the record barren. The Court was not warranted in making an affirmative finding that Smith had made no claim.

7. In refusing to hold that Smith's testimony was admissible under the exception to Section 347 of the New York State Civil Practice Act. If the admission in evidence of the original copyright certificate containing Taylor's unsworn statement that he was the author of the musical composition for which he made a claim of copyright was accepted as prima facie evidence of sole authorship by Taylor, such acceptance was the equivalent of accepting Taylor's testimony, and, therefore, constituted a waiver or exception to the incompetency of the co-author, Smith, to testify under the "Dead Man's Statute".

POINT I

Section 55 of the Copyright Law did not warrant the acceptance of the original copyright certificate as prima facie proof of Taylor's sole authorship of the musical composition.

The essential part of Section 55 provides:

"Said certificate shall be admitted in any Court as prima facie evidence of the facts stated therein."

The facts stated in the certificate (Ex. 1) are:

"1. That two copies of the musical composition named therein were deposited in the Copyright Office under the provisions of the Act of 1909.

"2. That registration of a claim to copyright for the first term of 28 years from the date of publication was made in the name of Taylor for the musical composition—Words and music by Taylor."

The certificate did not, nor could the Register of Copyrights, certify to Taylor's sole authorship. It simply certified that Taylor had filed an unsworn statement that he had written the words and music.

Moreover, the framers of Section 55 could not have intended it to mean that the Register of Copyrights should certify to the truth of a fact of which it was impossible for him to have knowledge. The receipt of Taylor's claim of copyright accompanied by two copies of the musical composition did not involve any determination or investigation by the Register as to whether or not Taylor had actually been the sole author. Therefore, it would be illogical to have the Register certify as to the authorship.

In *Davies v. Bowes*, 219 Fed. 178 (C. C. A. 2), Judge Lacombe said:

"The statement in the certificate that they were received 'as copyright deposits' indicate nothing more

than that they were turned over to the office in attempted compliance with the copyright statute. The receipt of them by the Librarian does not involve any determination by him as to whether or not the deposit is made in time; he is not required to make any investigation when a copy is delivered to him or comes to him by mail as to what was the date of publication."

The certificate at best could be prima facie evidence only as far as authorized by Section 55 (*Weil, Law of Copyright*, p. 570).

This Court has not interpreted Section 55, although the need for such interpretation is essential in view of the various decisions of lower courts permitting it to be used in a broader sense than its language warrants.

The unjust effect of the improper use of Section 55 in this case is evident. The result was to deprive Smith, the defendant's assignor, who claimed to be co-author, of his day in court. Smith was held to be incompetent to testify under the provisions of the New York State "Dead Man's Statute" (C. P. A. Sec. 347) because his co-author, Taylor, had in the meantime died. Thus, Smith's right to establish his co-authorship was effectively quashed. By reading into the copyright certificate facts that are not certified to and then by gagging Smith under the "Dead Man's Statute" plaintiff was enabled to secure an injunction against defendant. At the same time the fact that the two copies of the musical composition filed by Taylor with his claim for copyright contained admissions that Smith was a co-author, was wholly ignored.

POINT II

Assuming, arguendo, that Smith had made no claim during the original term of copyright, he was not precluded from making application for the renewal term.

The fundamental structure of the Copyright Law which gives the right to both the author and the proprietor to obtain copyright for the original term definitely reserves the right to the renewal term solely to the author.

There was but one issue presented: Was Smith a joint author? If he was, of course, he was jointly interested in the renewal term of copyright (17 U. S. C. A., Sec. 23).

Either a "proprietor" or an "author" has the right to obtain copyright for the original term (17 U. S. C. A., Sec. 8). The "proprietor" is one who takes title to a work by assignment from the "author" (*Mifflin v. R. H. White*, 190 U. S. 260; *Weil, Law of Copyright*, Sec. 431, p. 168).

But the right to claim a renewal term of copyright is vested solely in the author (17 U. S. C. A., Sec. 23). A proprietor has no such renewal rights. The statute is framed to protect authors, and for that reason the right to the renewal term is vested in the author, irrespective of the disposition of the first term. The intent of Congress in enacting Section 23 was to give to authors the fruits of their labors by means of a separate right in the renewal copyright (*Witmark v. Fisher*, 38 Fed. Supp. 72, aff'd 125 F. [2d] 949, aff'd 318 U. S. 643). The renewal is deemed a separate estate. It is a new grant (*Fox Film v. Knowles*, 261 U. S. 326). A sale of the original copyright carries no interest in the renewal term of copyright unless it is definitely mentioned (*Witmark v. Fisher*, 318 U. S. 643; *Rossiter v. Vogel*, 134 F. [2d] 908).

Therefore, what Smith had done during the original term was immaterial for it could not affect his vested right to the renewal.

In *Witmark v. Fisher*, 318 U. S. 643, at page 654, Mr. Justice Frankfurter said:

"By providing for two copyright terms, each of relatively short duration, Congress enabled the author to sell his 'copyright' without losing his renewal interest. If the author's copyright extended over a single longer term, his sale of the 'copyright' would terminate his entire interest. That this is the basic consideration of policy underlying the renewal provision of the Copyright Act of 1909 clearly appears from the report of the House committee which submitted the legislation (the Senate committee adopted the report of the House committee, see Sen. Rep. 1108, 60th Cong., 2nd Sess.): * * *."

Smith might well have made some deal with Taylor with respect to his interest in the original copyright term, or even have transferred or sold such interest, but that would not affect his right to the renewal term. An author can claim the right of renewal even if he has sold or transferred his manuscript and copyright originally is obtained thereon by the proprietor (*Mifflin v. R. H. White & Co.*, 190 U. S. 260, 262; *Public Ledger v. New York Times*, 275 Fed. 562, aff'd 279 Fed. 747).

The holding of the lower Court that if Smith had no interest in the original term he had no right to apply for and to receive a renewal certificate is without justification in law. It sets up a dangerous precedent which is contrary to the scheme of the copyright statute intended to protect the rights of authors.

POINT III

Smith's testimony was improperly excluded under Section 347 of the New York State Civil Practice Act known as the "Dead Man's Statute" for the following reasons:

A. Under established New York law the testimony was competent and should have been received in support of defendant's denial of plaintiff's affirmative claim.

B. It was admissible under the exception of Section 347 of the New York State Civil Practice Act which waives the incompetency of a witness where the plaintiff places the testimony of the deceased in evidence.

C. Section 347 was intended as a shield not a sword. It was not meant to be used as an instrument of injustice, by the successor to the interest of a deceased person.

A.

The decision of the Circuit Court misconceived the issues presented. It erroneously assumed that defendant had set forth an affirmative defense upon which it had the burden of proof and that Smith's testimony was offered to establish such affirmative defense. The opposite actually was the fact. The Circuit Court said:

" * * * The appellant had the burden of establishing its affirmative defense and we are not persuaded that the District Judge was clearly wrong in holding that it failed to do so" (R. p. 125).

Since defendant had no affirmative defense, it could not possibly in fact or in law have had the burden of proving one. Ownership and sole ownership were part of plaintiff's case. Moreover, plaintiff had alleged that Taylor was the sole author and that Smith was not a co-author.

Defendant had denied the plaintiff's claim and was in the position of offering proof in support of such denial. Smith's testimony actually was offered to negate plaintiff's claim and should have been received. It was competent testimony to overthrow the facts upon which plaintiff's claim of sole ownership rested (*Lewis v. Merritt*, 98 N. Y. 206).

The opinion of the Circuit Court makes it abundantly clear that it upheld the exclusion of Smith's testimony on the theory that defendant had offered it in support of an affirmative defense. The Circuit Court, in referring to *Lewis v. Merritt*, supra, said:

" * * * In that case, it was said, however, that Section 347 applies to exclude evidence that will establish a cause of action or an affirmative defense and the latter is the situation here" (R. p. 126).

The foregoing statement of the Circuit Court appears to be a direct concession that, had the issue been correctly appraised, Smith's testimony would have been received. The basic error was the unfounded assumption that it was offered for a purpose other than to negate plaintiff's affirmative claim.

The lower Courts, bound by the doctrine of *Erie R. Co. v. Tompkins*, 304 U. S. 64, were required to follow the construction of the New York State Court of Appeals of Section 347 as set forth in *Lewis v. Merritt*, supra. The conclusion is inescapable under such construction that the exclusion of Smith's testimony was reversible error.

B.

Petitioner urged below that the admission in evidence of the original copyright certificate and its acceptance as prima facie evidence that Taylor was the sole author of the musical composition was equivalent to accepting the testimony of Taylor and therefore constituted a waiver of the incompetency of Smith.

Section 347, C. P. A., states an exception to the rule of incompetency, as follows:

"where the testimony of deceased is placed in evidence."

The only evidence that Taylor was either co-author or sole author of the musical composition was the registration of his claim to copyright based upon his own statement that he was such author, which registration was certified to in the copyright certificate (Ex. 1).

Smith was prevented from telling his story in rebuttal of such statement.

If the incompetency of a witness to testify to a personal transaction with the deceased is waived when the successor in title of the deceased offers the testimony of the deceased, then defendant at bar should have been allowed, by Smith's testimony, to rebut Taylor's statement of authorship which was accepted as part of the copyright certificate even though unsworn.

Either Taylor's statement should not be considered as of sufficient quality to establish prima facie proof of his sole authorship or, in the alternative, it should be considered as within the exception of Section 347 of the New York State Civil Practice Act (*Kings County Trust Co. v. Hyams*, 242 N. Y. 405; *Matter of Boesenbergh*, 265 App. Div. 484).

Taylor's claim for copyright was in fact a statement of a personal transaction with Smith. It was a denial by Taylor that Smith was a co-author. Therefore, Smith should not have been prevented from giving the entire transaction or stating his version of what occurred (*Merritt v. Campbell*, 79 N. Y. 625).

C.

The purpose of Section 347 was to prevent undue advantage. It was intended to act as a shield, not a sword (*Lawyers v. White*, 198 N. Y. 318). It was not enacted for the purpose of enabling an estate or the successor of

a deceased to make a claim against another and then prevent such other from answering the charge.

In *Lewis v. Merritt*, 98 N. Y. 206, it is pointed out that the object of Section 829, C. C. P. (now Sec. 347, C. P. A.), will be accomplished if limited to cases which preclude evidence offered for the purpose of establishing an affirmative cause of action or defense.

POINT IV

The exclusion of Smith's testimony having left the record barren of evidence of what Smith did during the original term of copyright, there was no justification for the affirmative conclusion that Smith had made no formal claim.

The plaintiff was not entitled to any favorable inference concerning Smith's actions during the original term in the absence of testimony in that regard. If it were necessary to show Smith had made no formal claim, it was the plaintiff's burden to adduce such proof to establish its claim. The Trial Court seemingly recognized that fact, for it said:

"The plaintiff sues for a declaratory judgment, claiming that one Tell Taylor was the sole author of the song * * *. That Earl K. Smith is not a co-author of the song * * * and therefore has no right to a renewal copyright on the song" (R. f. 332).

Yet the Trial Court inconsistently placed the burden of proving Smith's co-authorship on defendant, making defendant's failure to meet such burden a controlling factor. The Court said:

"The record discloses no evidence that Smith at any time during the lifetime of Taylor ever asserted a formal claim of co-authorship" (R. f. 333).

The Circuit Court, emphasizing the error below, said in its opinion:

" * * * yet the fact that Smith had made no legal or formal claim to the copyright during almost all of the entire 28 years of its original term was a circumstance to be considered by the Court upon the issue of co-authorship by Smith * * * " (R. p. 128).

It is urged that it was wholly immaterial as to what Smith did during the original term, as demonstrated under Point I, *infra*. The emphasis below on the fact that Smith had made no formal claim, which is unsupported by evidence, is a clear indication of the confusion and misunderstanding by the Courts below of the basic issues presented both in fact and in law.

CONCLUSION

Petitioner therefore prays that a writ of certiorari should be granted in this case.

Respectfully submitted,

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on the Brief.